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In re Application of SACCO et al :
U.S. Application No.: 09/486,660 :
Int. Application No.: PCT/IT98/00231 :
Int. Filing Date: 11 August 1998 : DECISION
Priority Date: 28 August 1997 :
Attorney Docket No.: 471-129P (previously SCBREV-223) :
For: TRANSGENIC ANIMALS FOR THE STUDY OF :
BIOLOGICAL, PHYSICAL, AND CHEMICAL :
TOXIC AGENTS :

This is in response to applicants' "Supplemental Renewed Request for Status Under 37 CFR 1.42 and Renewed Petition Under 37 CFR 1.43(A)" filed 29 October 2001 and "Second Supplemental Renewed Request for Status Under 37 CFR 1.42 and Renewed Petition Under 37 CFR 1.47(A)" filed 07 December 2001, requesting that the application be accepted for national stage processing without the signatures of legal representatives of certain heirs of joint inventor Romeo Roncucci, who is deceased.

BACKGROUND

On 11 August 1998, applicants filed international application PCT/IT98/0023, which claimed priority of an earlier Italy application filed 28 August 1997. A copy of the international application was communicated to the USPTO from the International Bureau on 11 March 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 March 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 28 February 2000.

On 28 February 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 28 April 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge

under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 24 October 2000, applicants filed a request for status under 37 CFR 1.42, a petition under 37 CFR 1.47(a), a declaration executed by five of the six inventors, and declarations signed by certain legal representatives.

On 30 April 2001, this Office mailed a decision dismissing the request for status and petition.

On 28 September 2001, applicants filed a renewed request for status under 37 CFR 1.42 and a renewed petition under 37 CFR 1.47(a).

On 29 October 2001, applicants filed the present supplemental renewed request for status under 37 CFR 1.42 and renewed petition under 37 CFR 1.47(a). The submission is accompanied by a declaration executed by the living joint inventors and a declaration executed by Maria Novella Castagnoli.

On 28 November 2001, this Office mailed a decision dismissing the 28 September 2001 renewed request for status and petition.

On 07 December 2001, applicants filed the present second supplemental renewed request for status under 37 CFR 1.42 and renewed petition under 37 CFR 1.47(a). The submission is accompanied by a copy of a letter signed by Sylvie Roncucci.

DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." The response states that deceased inventor Romeo Roncucci has four heirs: Sylvie Roncucci, Rachele Roncucci, Regine Roncucci, and Roxanne Roncucci.

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

Sylvie Roncucci

The 07 December 2001 renewed petition states that Sylvie Roncucci refuses to sign the application papers.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by joint inventors Maria Grazia Sacco, Luigi Zecca, Peter Bromley, Libero Clerici, and Paolo Vezzoni, each on his/her own behalf and on behalf of Romeo Roncucci.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a complete copy of the application papers to Sylvie Roncucci for signature. Specifically, while the letter dated 19 November 2001 states that Sylvie Roncucci acknowledges receipt of the declaration, neither the letter nor the petition states that the specification, claims, and drawings were ever presented to Sylvie Roncucci. If the specification, claims, and drawings were in fact presented to Sylvie Roncucci, a statement to that effect, signed by the person with firsthand knowledge of the correspondence, should be provided.

With regard to item (3) above, applicants have provided the requisite fee.

With regard to item (4) above, the petition does not state the last known address of Sylvie Roncucci.

Because applicants have failed to satisfy items (2) and (4) above, it would be inappropriate to conclude at the present time that Sylvie Roncucci refuses to sign the application papers.

Rachele Roncucci and Regine Roncucci

37 CFR 1.43 provides, "In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent." Applicants have submitted a declaration signed by Maria Novella Castagnoli, guardian of Rachele Roncucci and Regine Roncucci, who according to the response are minors.

The 29 October 2001 declaration signed by Maria Novella Castagnoli is acceptable under 37 CFR 1.42, 37 CFR 1.43, and 37 CFR 1.497.

Roxanne Roncucci

The 07 December 2001 renewed petition states that applicants have been unable to obtain the signature of Anne Georgette Christiane Delachet, guardian of Roxanne Roncucci, who according to the response is a minor.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted the requisite declaration.

With regard to item (2) above, applicants have not sufficiently established that Ms. Delachet's conduct constitutes a refusal to sign the application papers for the reasons set forth in the decision mailed 28 November 2001. Furthermore, the exceptionally brief four day period in which Ms. Delachet was required to respond is deemed inadequate. The 07 December 2001 renewed petition states that "repeated attempts" have been made to obtain Ms. Delachet's signature, but applicants have not provided details concerning any such attempts made after Ms. Delachet was presented with the application papers.

With regard to item (3) above, the requisite petition fee has been provided.

With regard to item (4) above, the renewed petition states the last known address of Ms. Delachet (see Bromley's affidavit filed 28 September 2001).

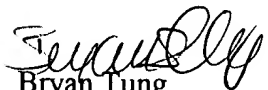
Because applicants have failed to satisfy item (2) above, it would be unreasonable to conclude at the present time that Ms. Delachet refuses to sign the application papers.

CONCLUSION

For the reasons above, the renewed request for status under 37 CFR 1.42 and the renewed petition under 37 CFR 1.47(a) are **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42 and Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time pursuant to 37 CFR 1.136 are available.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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